



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,369	06/28/2000	John R. Stuelpnagel	A-67493-3/DJB/RMS/DCF	6020

7590

04/08/2003

Flehr Hohbach Test Albritton & Herbert LLP
Suite 3400
Four Embarcadero Center
San Francisco, CA 94111-4187

EXAMINER

BEISNER, WILLIAM H

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 04/08/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/606,369

Applicant(s)

STUELPNAGEL ET AL

Examiner

William H. Beisner

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 Jan. 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-18, 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 13-18, 29, 30 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehead et al.(US 4,879,097) in view of Kolehmainen et al.(US 4,349,510).

The reference of Whitehead et al. discloses a device for forming a chamber which includes a base plate (10, 11) which holds a microtiter plate (16, 17). The device includes a lid including component ports for immobilizing array components (28 or 350). The device includes sealant (21) between the base and the lid. The device includes male/female alignment means (22). As shown in Figure 11, the chamber is connected to at least one fluid handling device (350).

While the reference of Whitehead et al. discloses sealant, 21, so as to seal the chamber to prevent entry of stray light, the instant claims recite that the sealant provides an "airtight" seal.

The reference of Kolehmainen et al. discloses an optical analysis system which detects chemiluminescence. The reference of Kolehmainen et al. discloses that a light-tight seal can be maintained using an o-ring, 38 (See column 4, lines 6-27). The light-tight seal prevents external light from interfering with the detector.

In view of this teaching and in the absence of a showing of criticality and/or unexpected results, it would have been obvious to one of ordinary skill in the art to employ an o-ring seal in place of seal, 21, in device of Whitehead et al. for the known and expected result of providing an

Art Unit: 1744

alternative means recognized in the art to achieve the same result, sealing the interior of the reaction region from exterior light. Use of an o-ring as suggested by the reference of Kolehmainen et al. would inherently result in an airtight seal.

With respect to claim 14, the lid of the device of Whitehead et al. includes openings or ports which would be capable of holding a fiber optic bundle. Note claims 13 and 14 do not positively recite the bundle, only a port for immobilizing a fiber optic bundle.

With respect to claim 31, the references of Kolehmainen et al. discloses that it is known in the art to monitor chemiluminescent or bioluminescent reactions performed in microtiter plate arrays using an array of fiber optic devices (See Figure 4 of Kolehmainen et al.).

In view of this teaching and in the absence of a showing of criticality and/or unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a fiber optic array in the lid structure of the reference of Whitehead et al. for the known and expected result of providing an alternative means recognized in the art to detect chemiluminescent reactions. Provision of the fiber optic and electrical detection system would provide increased reliability over the use of photographic film which is analyzed visually.

Response to Arguments

3. Applicant's arguments filed 09 Jan. 2003 have been fully considered but they are not persuasive.

With respect to the combination of the references of Whitehead et al. and Kolehmainen et al., Applicants argue that the combination of the references is improper because the Examiner has failed to point to anything specific in the cited references that would suggest the motivation

Art Unit: 1744

to combine the reference of Whitehead with the secondary reference of Kolehmainen et al.

Applicants take the position that the Examiner has merely made a "common sense" argument which is impermissible.

In response, Applicants' comments are not found to be persuasive because the Examiner is of the position that the substitution of known equivalents known for the same purpose meets the requirements set forth in 35 USC 103. The prior art of record establishes that both photographic film and fiber optic detectors are known detection systems in the art of chemiluminescent detection. Note an express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious (See *In re Fout*, 213 USPQ 532 (CCPA 1982)).

With respect to Applicants' comments which state that even if the above combination was proper, the combination would not meet the limitations of the instant claims, the Examiner was addressed the new limitation of "airtight" in the modified prior art rejection above.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


Art Unit: 1744

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Beisner whose telephone number is 703-308-4006. The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:40am to 4:10pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 703-308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


William H. Beisner
Primary Examiner
Art Unit 1744

WHB
April 7, 2003